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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/625,325

Filing Date: July 23, 2003

Appellant(s): GUENTHER ET AL.

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Terence O'Brien  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 12, 2007 appealing from the Office action mailed June 12, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

11/018,628

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- a.      Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). All of claims 1-14 and 51-64 are not rejected under the combination of Horkan in view of Martin as appellant states. Attention is directed to the basis for the rejection set forth in the Final Rejection mailed June 12, 2007.

**GROUNDS OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. Claims 1-14 and 51-64 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51 and 53-65 of copending Application No. 11/018,628. As per the appellant's remarks, the appellants do not object to this rejection and are prepared to submit a terminal disclaimer to obviate the double patenting rejection.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,570,882	Horkan	11-1996
4,570,931	Martin	02-1986
6,283,881	Feeaney	09-2001
4,991,842	Finley	02-1991

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Regarding claim 1, Horkan discloses a football construction including laces that have hook or loop fasteners thereon for improving the gripping of the ball. Note column 1, lines 65-67 stating that an object of the training aid is to improve the user's grasping and control of the football. Further, note column 2, lines 51 and 52 stating that the fastener merely replaces the conventional lacing. Thus, Horkan

teaches that it is known in the art of footballs to modify the laces of a football for improving the grip thereof.

Martin discloses that it is well known in the art of game balls to provide projections or a pebble design on the surface of the ball in order to improve its grippability. Note column 1, lines 8-25 of Martin. Therefore, because Horkan teaches that it is known in the art of footballs to modify the texture of the surface of the laces and Martin teaches that a pebbled surface is a well known means for improving the grip on the surface of a ball, it would have been obvious to one of ordinary skill in the art to modify the laces of a conventional football by providing a pebbled surface therefor in order to improve the grip by a user on a conventional football. The combination of Horkan in view of Martin would teach a highly grippable surface for the laces. Further, the ball of Horkan in view of Martin is obviously capable of being used in competitive play and being grasped by the hand of a user. Horkan particularly teaches that the laces of the ball are enhanced in order to improve grasping thereof by the hand of the user. Also, the projections of Martin when placed on the laces will obviously be projecting outwardly from the football.

Regarding claims 2 and 3, the projections of Martin are described as pebbles.

Regarding claims 5 and 7, Martin teaches arranging equal sized pebbles in an evenly spaced pattern. It would have been obvious to one of ordinary skill in the art to place the equal sized pebbles in an evenly spaced pattern on the laces in order to provide an aesthetically pleasing design for the ball.

Regarding claims 9 and 10, note Figure 9 of Martin showing the height and width for the projections. The claimed aspect ratio is considered to be obvious given the teachings of Martin

and the lack of a showing of the criticality for the claimed aspect ratio by a new and unexpected result obtained therefrom.

Regarding claims 51-64, note column 3, lines 12-17 of Martin stating that other shapes may also be used as projections. It would have been obvious to one of ordinary skill in the art to provide the laces of Horkan with the shapes taught by Martin order to provide an alternative textured surface that also improves the gripping of the football and does not rely on the use of the glove. Further, any other shapes claimed by appellant and not disclosed by Martin (oval, irregular) are considered to be obvious given the teachings of Martin and the lack of a showing of the criticality for the claimed shapes by a new and unexpected result obtained therefrom.

2. Claims 4, 8, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Feeney (6,283,881). Regarding claim 4, Feeney discloses a game ball construction including a plurality of differently shaped projections on the surface of the ball (note Figure 8 and column 5, lines 16-30). It would have been obvious to one of ordinary skill in the art to provide differently shaped projections on the laces of the ball of Horkan as modified by Martin in order to arrange a particular design for the ball while still improving the grip.

Regarding claim 8, the projections of Feeney are of varying sizes.

Regarding claim 11, Horkan teaches lacing that provides a plurality of longitudinally extending segments and a plurality of transversely extending segments. It would have been obvious to one of ordinary skill in the art to apply a first shaped projection to the longitudinal segments and a second shape to the transverse segments as the appellant has not disclosed that this particular arrangement is for any particular purpose or solves any stated problem and it

appears that the arrangement of Horkan as modified by Martin and Feeney would accomplish similar purposes.

Regarding claim 12, Horkan teaches hook fasteners along the entire surface of the lacing. To replace the hook fasteners with the projections of Martin would obviously also place projections along the entire surface of the lacing.

Regarding claim 14, it would have been obvious to one of ordinary skill in the art to form the lacing of Horkan from a polyurethane material in order to take advantage of that material's well known physical properties.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (6,629,902) in view of Martin (4,570,931) and Finley (4,991,842). Finley reveals a grip enhanced basketball where the projections are randomly placed. It would have been obvious to one of ordinary skill in the art to randomly place the projections on the laces of the ball of Horkan as modified by Martin in order to provide a particular design pattern for the laces.

#### **(10) Response to Argument**

##### *A. Claims 1-3, 5, 7, 9, 10 and 51-64*

Regarding the rejection under 35 U.S.C. 103(a) of the claimed invention over Horkan in view of Martin, the appellant argues that the combination does not teach the elements of claim 1. The appellant argues that neither Horkan nor Martin teach a lacing for a football having an exposed surface which comprises a pebbled texture and that is highly grippable when directly contacted by a user's hand. The appellant argues that the hook and loop fastening material of Horkan is not highly grippable by a user's bare hands as evidenced by the appellant's lab results (Section vii. D.).

However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, the rejection is over the combination of Horkan in view of Martin. Horkan teaches that it is known in the art of footballs to modify the laces in order to improve the grippability of the football. Martin teaches that it is well known in the art of game balls to provide a pebbled surface on a game ball in order to improve its grippability. Note column 1, lines 65-67 of Horkan and column 1, lines 8-25 of Martin. It would have been obvious to one of ordinary skill in the art to modify the laces of a football by providing a pebbled surface thereon as Horkan suggests modifying the laces of a football to improve the grippability thereof and Martin teaches that one method of improving the grippability of a game ball is to provide a pebbled surface thereon.

The appellant also argues that Horkan teaches away from the combination by teaching a high level of grippability of the football only between the gloved fingertips of the user and the lacing of the football. However, Horkan's teaching is not seen as teaching away from the combination of Horkan in view of Martin. The placement of the loop elements at only the fingertips of the glove is commensurate with the teachings of Martin as it is well known in the art that it is the user's fingertips which engage the laces of the football for throwing purposes. Just like the engagement between the hook elements on the laces and the loop elements on the fingertips in the invention of Horkan provides a positive feedback so would the engagement between pebbles on the laces and the user's fingertips in the combination of Horkan in view of Martin.

Further, the references are not seen as teaching away from one another and are seen as being properly combined. Horkan provides a football construction where the laces are modified in order to improve the gripping ability of the ball. Note column 1, lines 62-67 of Horkan stating that the objectives of the invention are to properly impart spin to a thrown football and improve the user's grasping and controlling of the football. Clearly, these objectives would suggest to one of ordinary skill in the art to look to other game ball arrangements for structures that could be incorporated into the laces of a football that would also improve the gripping and controlling of the football. The reference to Martin provides such a solution by teaching pebble-like projections on the surface of a basketball that improve its gripping and controlling. Note column 1, lines 18-25 and column 2, lines 30-36 of Martin. These passages disclose that the pebble-like projections improve the gripping of the ball. Thus, contrary to appellant's argument, the reference to Horkan provides a suggestion to one of ordinary skill in the art to provide the laces of a football with alternative arrangements that would also improve the gripping and controlling of the football. Martin provides a solution to the suggestion by providing pebble-like projections that are taught as improving the gripping of the basketball.

Regarding the appellant's argument that Horkan provides a training aid for young football players which usually have to cradle a ball in palm-up fashion in order to pass the ball, while this may be true, it does not change the fact that providing the projections of Martin on the lacing surface would still accomplish the stated objectives of both references and would also provide other advantageous aspects not obtained by the hook and loop fasteners such as the elimination of the glove and the direct grasping of the football on the laces by the user's hand.

The appellant also argues that Horkan consistently teaches that it is the combination of the glove and laces of Horkan which provide the training aid. The appellant points to a number of passages in the specification of Horkan demonstrating the interaction between the glove and the lacing of the football. However, the appellant has taken a very narrow reading of the teachings of Horkan and stated that they teach away from the instant invention. The citations of Horkan merely exemplify that Horkan is indeed concerned with improved grippability of the user at the laces. The general teaching of Horkan is that it is known to modify the laces of a football by applying a textured surface thereto in order to improve the grippability of the laces. Even though Horkan provides a particular relationship between the user and the ball (the hook and loop fasteners) the broader teaching of Horkan is that the laces of a football may be modified in order to improve the grasping and control of the football. Similarly, Martin teaches that it is known in the art of game balls to improve the grasping and control of the game ball by providing projectiles on the surface. It would have been obvious to one of ordinary skill in the art to modify the laces of a conventional football by providing a plurality of projections thereon in order to improve the grip by the user on the football.

Regarding the appellant's argument that Horkan specifically teaches a high level of grippability only between the gloved fingertips of the user and the lacing of the training football, as stated above, the general teaching of Horkan is that it is known in the art to modify the laces of a football by applying a textured surface in order to improve the grippability of the laces. By applying the projections of Martin to the laces of a football, one of ordinary skill in the art would recognize that the football would still achieve a high level of grip-ability between the fingertips of the user and the lacing of the football.

The appellant also argues that the combination of Horkan in view of Martin would not accomplish the objectives of Horkan because the combination would not urge only the user's fingertips into contact with the laces. However, the combination of Horkan in view of Martin teaches the claimed invention and is properly combined. Horkan suggests modification of a football's laces by providing a textured surface therefor. Martin teaches that projections are a well known means for improving the grip on a game ball surface. It would have been obvious to one of ordinary skill in the art to modify the laces of a conventional football by providing a plurality of projections thereon in order to improve the grip by the user on the football.

Further, the combination of Horkan in view of Martin is capable of accomplishing all of the objectives outlined by Horkan. Attention is directed to column 1, lines 50-67 of Horkan listing the objectives of his invention. The football created by the combination of Horkan in view of Martin is capable of: 1) assisting in proper throwing of a football, 2) creating interaction between the user's fingertips and the laces of the football, 3) not interfering with the normal play of the game, 4) allowing a player to impart a spin to a thrown football and 5) improving a user's grasping and control of the football. Applying the pebbles of Martin to the laces of a football would inherently improve the grip of the football of the user. Improving the grip of the football would allow a user to be more able to impart a spin to the thrown football. The application of the pebbles of Martin to the laces of a football would urge the user's fingertips into proper engagement with the laces of the football as he would receive tactile feedback when his fingertips contact the pebbles on the laces.

*B. Re: Column 1, lines 62-67 of Horkan*

The appellant argues that the training aid of Horkan is solely directed to the combination of a modified football and glove combination. However, this is not persuasive as it is the combination of Horkan in view of Martin which is relied upon for teaching the claimed invention. While Horkan specifically teaches a combination of the hook and loop fasteners in order to accomplish this objective, Horkan is clear in stating that providing increased frictional contact between the fingers and the laces such as by a textured surface for the lacing improves the grasping and throwing of the football. Further, the combination of the glove and laces of Horkan provides a suggestion to one of ordinary skill in the art to look at other arrangements for the laces that would also improve the frictional contact between the laces and the user's grip. Martin teaches that it is well known in the art of sports balls to provide pebble-like projections on the surface of a sports ball in order to improve its gripping and controlling. Given the suggestions of Horkan to improve the frictional contact between the laces and the user's grip and of Martin that providing projections on a surface improves its gripping ability, it would have been obvious to one of ordinary skill in the art to provide pebble-like projections on the laces of a football in order to improve the grip and control of the ball.

*C. Re: Reexamination of 6,964,625*

The appellant refers to the Reexamination of 6,964,625 and the comments provided by the Reexamination Officer, specifically his reasons for patentability. However, these arguments are not persuasive. First, it is noted that it is Patent Office policy to not comment on the prosecution and remarks of another patent application. Second, it is noted that the claims to which the reasons for patentability pertain are different from the instant claims. The claims of the Reexamination recite an inner substrate and an outer layer for the lacing which is not recited

in the instant claims. While the Reexamination Officer directs comments to Horkan and the grip-ability between the gloved fingertips and the lacing of the training football, it is also noted that he states that Horkan also lacks the teaching for a lacing comprising an inner substrate with an outer layer. Further, it is unclear if the Reexamination Officer had the Martin reference available when he considered the Horkan reference.

*D. Independent Lab Testing*

The appellant argues that according to the Lab Results provided as Exhibit C of the Evidence Appendix, the hook material provided separately has less frictional resistance to a user's hands than other materials such as synthetic leather or natural leather. While this may be true, the rejection of the claimed invention is over the combination of Horkan in view of Martin where the hook and loop fasteners are replaced with the raised projections of Martin. Further, claim 1 does not define any coefficients of friction as set forth in the test results nor does it provide any qualitative measure for what comprises a "highly grippable surface". The combination of Horkan in view of Martin teaches a football with laces having projectiles thereon. Martin teaches forming a highly grippable surface by providing projectiles on the surface. By providing the projectiles on the laces of the football, the combination of Horkan in view of Martin will provide a pebbled texture that is highly grippable when directly contacted by a user's hand.

*E. Claims 4, 8, 11, 12 and 14*

Regarding the combination of Horkan in view of Martin and Feeney, the reference to Feeney is relied upon simply for its teaching that it is well known in the art of game balls to provide projections of various shapes.

*F. Claim 6*

Regarding the combination of Horkan in view of Martin and Finley, the reference to Finley is relied upon merely for its teaching that it is well known in the art of game balls to randomly place projections on the surface of the ball. The references to Horkan and Martin teach the recited elements of claim 51.

*G. Claims 1-14 and 51-64 as rejected on the ground of Nonstatutory Obviousness-Type Double Patenting*

**GROUNDS OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. Claims 1-14 and 51-64 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51 and 53-65 of copending Application No. 11/018,628. As per the appellant's remarks, the appellants do not object to this rejection and are prepared to submit a terminal disclaimer to obviate the double patenting rejection.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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